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09/690,368

10/16/2000

Tracey L. Jones

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01/12/2006

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EXAMINER

LUDWIG, MATTHEW J

ART UNIT

PAPER NUMBER

2178

DATE MAILED: 01/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/690,368

Applicant(s)

JONES ET AL.

Examiner

Matthew J. Ludwig

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) 3,4,11,12,19 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-10,13-18 and 21-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 3,4,11,12,19 and 20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is in response to the RCE filed 10/26/05.
2. Claims 1-45 are pending in the application. Claims 1, 3, 9, 11, 17, 19, 43, 44, and 45, are independent claims.
3. The rejection of claims 1, 9, and 17, under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter has been withdrawn as necessitated by the amendment. Furthermore, the rejection of claims 1-24, under 35 U.S.C. 103(a) as being unpatentable over Stern in view of Hennings has been withdrawn pursuant to applicant's arguments.

Election/Restrictions

Election by Original Presentation

4. ***The submitted claims, 3, 4, 11, 12, 19, and 20, are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:***
In reference to independent claim 3, 11, and 19, the claims were amended and rewritten in independent form. The newly added claim language within the independent claim recites a means for query processing and searching which, when read as a whole, describes a different invention than what was originally presented. The claims are directed toward query formulation, input preparation, or translation, which fall into a separate class, 707/3 and 707/4, Data Processing: Database and File Management or Data Structures. The claims would require undue burden on the examiner to search two distinct inventions. The applicant presented claims directed to an invention distinct from and independent of the invention previously claimed, the

Art Unit: 2178

applicant will be required to restrict the claims to the invention previously claimed if the amendment is entered.

Since applicant has received an action on the merits for the originally presented invention, The invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 3, 4, 11, 12, 19, and 20, are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. **Claim 28 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

In reference to dependent claim 28, the claim recites the phrase “*wherein the electronic version is a second version of the paper*”. There is insufficient antecedent basis for this limitation in the claim. It is unclear to the Examiner what version is the second version of the paper.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

Art Unit: 2178

such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 2, 5-10, 13-18, and 21-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuppusamy et al., USPN 6,769,096 filed 6/24/1998.

In reference to independent claim 1, Kuppusamy teaches:

Once the frameset is created, the contents (quarterly report) of both documents can be saved as HTML documents in an Internet browser-readable format (compare to “*storing an electronic version of a paper, the version being displayable on a display device as a likeness of the paper*”). See column 10, lines 8-16.

A heading is detected within the first location of the quarterly report, which provides a reference to a second location within the quarterly report (compare to “*detecting a reference to a second location, wherein the detected reference is a phrase*”). See column 7, lines 45-67.

The creation of the entries in the TOC document occurs once the selected headings are identified. A hyperlink entry is created in the TOC document for each selected heading (compare to “*in response to the detected reference, embedding a hyperlink within the first location*”). See column 8, lines 25-38.

The text of the entry into the TOC document may be displayed in a different color than ordinary text, or the text of the entry may be underlined to identify its linking function. In the screen display, the links are displayed as underlined text (compare to “*when the first location is displayed on the display device, highlighting the first location to indicate the hyperlink as being selectable by a user to cause an operation associated with the second location*”). See column 8, lines 48-60.

The examiner believes the first location is taught by quarterly report and the TOC document. The reference provides the two separate pieces of information related to each other in one display. Highlighting the first reference would equate to underlining/changing the color of the section name found within the quarterly report. The creation of the entries in the TOC document occurs once the selected headings are identified. The reference fails to explicitly state highlighting the first display; however, the known technique of underling/changing the color of hyperlinked text was well known by one of ordinary skill in the art at the time the invention was made and provides a similar method of highlighting which in turn would give the user an improved way to identify a linking function.

In reference to dependent claim 2, Kuppusamy teaches:

A hyperlink entry is created in the TOC document for each selected heading. A hyperlink has two components: a link and an anchor. The link is a specially activated word, phrase or image in the TOC document that, when triggered, transfers the focus to the anchor in the target document. See column 8, lines 25-47. The reference describes two distinct sections or frames on a display device. The TOC includes hyperlinks that are associated with multiple sections of the target document (compare to “*displaying a first selector associated with a first portion of the paper, displaying a second selector associated with a second portion of the paper*”). See column 8, lines 25-47

In reference to dependent claim 4, Kuppusamy teaches:

The reference provides a hyperlink entry created in the TOC document for each selected heading. A hyperlink has two components: a link and an anchor. The link is a specially activated word, phrase, or image in the TOC document that, when triggered, transfers the focus to the

Art Unit: 2178

anchor in the target document. See column 8, lines 25-47. The reference fails to explicitly disclose the second location external to the paper; however, the two separate documents (the TOC and the target document) could be considered as providing a link to a document external to the target document.

In reference to dependent claim 5, Kuppusamy teaches:

Each entry is functional to cause the target document to scroll in the right frame until the heading corresponding to the entry comes in to view. See column 9, lines 42-46.

In reference to dependent claims 6 & 7, Kuppusamy fails to expressly teach a zoom function or an enlarged format, however, the Examiner takes Official Notice that the use of a zoom function and enlarging a format were well-known Microsoft Word options. The reference states the utilization of Microsoft Word, which includes several ways for viewing documents.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize Microsoft Word's many features for viewing documents presented to a user on a display since it would provide the user with enhanced viewing capabilities.

In reference to dependent claim 8, Kuppusamy teaches:

The text of the entry may be displayed in a different color than ordinary text, or the text of the entry may be underlined to identify its linking function. In the screen display the links are displayed as underlined text. Alternatively, the link may be a graphical image rather than text. See column 8, lines 50-59.

In reference to dependent claims 9, 10, 13-16, 43, and 44 the limitations reflect the system comprising computer readable instructions used for performing the methods as claimed in 1, 2, and 5-8. Therefore, the claims are rejected under similar rationale.

Art Unit: 2178

In reference to dependent claims 17, 18, 21-24 and 45, the limitations reflect the computer program product comprising computer readable instructions used for performing the methods as claimed in 1, 2, and 5-8. Therefore, the claims are rejected under similar rationale.

In reference to dependent claim 25, Kuppusamy teaches:

A heading is detected within the first location of the quarterly report, which provides a reference to a second location within the quarterly report (compare to “*detecting a reference to a second location, wherein the detected reference is a phrase*”). See column 7, lines 45-67.

In reference to dependent claim 26, Kuppusamy teaches:

In the disclosed embodiment, the Heading have been assigned that particular style and are, therefore, identified as entries for the TOC document. See column 7, lines 55-67. It would have been obvious to one of ordinary skill in the art at the time the invention was made to assign a particular style to any text including a page number because it would have given the user a means of collecting and separating pages and sections of a document based on the style of a page number.

In reference to dependent claim 27 & 28, Kuppusamy teaches:

When the link at Entry is triggered, the focus of the target document will shift to an anchor located at “quarterly report.html#Executive Summary”. See column 8, lines 55-67.

In reference to dependent claim 29, Kuppusamy teaches:

The creation of the entries in the TOC document occurs once the selected headings are identified. A hyperlink entry is created in the TOC document for each selected heading. A hyperlink has two components: a link and an anchor. See column 8, lines 25-45.

Art Unit: 2178

In reference to dependent claim 30, Kuppusamy teaches:

In the screen display, the links are displayed as underlined text. Alternatively, the link may be a graphical image rather than text. When the link is triggered, the focus of the target document will shift to an anchor located at “quarterly report”. See column 8, lines 48-67.

In reference to claims 31-36, the limitations reflect the system comprising computer readable instructions used for performing the methods as claimed in 25-30, respectively. Therefore, the claims are rejected under similar rationale.

In reference to claims 37-42, the limitations reflect the computer program product comprising computer readable instructions used for performing the methods as claimed in 25-30, respectively. Therefore, the claims are rejected under similar rationale.

Response to Arguments

9. Applicant's arguments with respect to claims 1-45 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Ludwig whose telephone number is 571-272-4127. The examiner can normally be reached on 9:00am-6:00pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2178

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ML

January 5, 2006



STEPHEN HONG
SUPERVISORY PATENT EXAMINER

Application/Control Number: 09/690,368
Art Unit: 2178

Page 10